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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,346	10/23/2001	Prathima Agrawal	1459-US	1318
9941	7590	01/13/2004		
TELCORDIA TECHNOLOGIES, INC. ONE TELCORDIA DRIVE 5G116 PISCATAWAY, NJ 08854-4157				
EXAMINER MEHRPOUR, NAGHMEH				
ART UNIT		PAPER NUMBER		
2686		11		
DATE MAILED: 01/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/453,346

Applicant(s)  
Prathima Agrawal et al.

Examiner  
Naghme Mehrpour

Art Unit  
2686



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 22, 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-14, 16-20, and 22-24 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-14, 16-20, and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2686

***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-3, 5-8, 10-14, 16-20, 22-24**, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,216,005. Although the conflicting claims are not identical, they are not patentably distinct

from each other because claims 1-14, of US patent 6,216,005 recites a mobile device of instant application encompass the subject matter previously patented.

Regarding **Claims 1, 5, 10**, Agrawal 6,216,005 teaches a system for enabling a telephone subscriber to switch an on going telephone call between wireline services provided through a central office in the public switched telephone network and cellular services provided by a mobile switching center in a cellular network, the subscriber wireline and cellular telephone being assigned different telephone numbers, said system (claim 1) comprising:

a routing table for identifying specific telephone subscribers entitled to switch on going telephone calls between wireline and wireless services (claim 9, col 18 lines 47-66, a routing table is a conventional table that is located in the central switching office, and addressed the calls to the third number),

a look-up identifying the correspondence of said one specific telephone subscriber's wire line and cellular telephones **numbers** (claim 4, col 17 lines 20-32, this table as explained in 6,216,005, and the specification of the present application on page 19 lines 3-4 lactated in the FCMA that is located in the MSC),

a monitor circuit responsive to a unique signal during **the existence of on-going telephone call** **telephone call involving the specific subscriber** from one specific telephone subscriber indicating a desired transfer between said one specific telephone subscriber's wireline and cellular telephones (claim 2, col 16 lines 52-56 and claim 3, col 17 lines 1-2) , and

switch means for effecting the transfer of the **on-going telephone call** (claim 4 col 17 lines 37-39, claim 2, col 16 lines 60-62, and claim 3, col 17 lines 8-13).

Regarding **Claim 3**, a system for enabling a telephone subscriber to switch an on-going telephone call between wireline services provided through a central office PSTN in the public switched

network and cellular service provided by a mobile switching center in a cellular network comprising:

a fixed cellular mobility agent associated with the mobile switching center, the fixed mobility agent having switching and signaling capabilities (claim 7, col 18 lines 15-17).

Regarding **Claim 16**, Agrawal 6,216,005 teaches a system for enabling a telephone subscriber to switch an on-going telephone call between wireline and cellular telephones to the other of the subscriber's telephones, **the subscriber wireline and cellular telephone being assigned different telephone numbers (claim 6 lines 56-60)**, the method comprising:

monitoring a call connection to one of the subscriber's telephone to detect a request by the subscriber to switch the **on-going connection** between the subscriber's telephones (claim 6, col 17 lines 62-63),

obtaining the telephone number of the other of the subscriber's telephones (claim 6, col 17 lines 63-64),

initiating an outgoing call from the other of the subscriber's telephones (claim 6, col 17 lines 67),

establishing a connection to the other of the subscriber's telephones (claim 6, col 18 lines 1-4), and

bridging the connections to the one and the other of the subscriber's telephones and terminating the connection to the one of the subscriber's telephones (claim 6, col 18 lines 5-6).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. **Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications indented for entry)

**Or:**

(703) 308-6306, (for informal or draft communications, please label

“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, Va., sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

If attempt to reach the examiner are unsuccessful the examiner's supervisor, Marsha Banks-Harold be reached (703)305-4379.

NM

Jan 11, 2004

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**